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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/517,163	04/05/2000	Sadahiko Hinoue	1247-0424P-SP	6242

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EXAMINER

HESSELTINE, RYAN J

ART UNIT

PAPER NUMBER

2623

DATE MAILED: 12/10/2002

Please find below and/or attached an Office communication concerning this application or proceeding.



# Office Action Summary

Application No.

09/517,163

Applicant(s)

HINOUE ET AL.

Examiner

Ryan J Hesselline

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 April 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,7,8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.



## DETAILED ACTION

### *Priority*

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### *Drawings*

2. The drawings are objected to because it appears that steps a128 and a129 in Figure 21 are reversed because they contradict the description on page 41, line 4-18. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### *Specification*

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: "Authenticating apparatus using a display/fingerprint reader."

### *Claim Objections*

4. Claim 13 is objected to because of the following informalities: Line 1 states, "the information processing of claim 11," it is believed that this should read "the information processing *apparatus* of claim 11." Line 8 states, "out of the files," this phrase is redundant and should be deleted. Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it



pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claim 16 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The “attendant processing means” stated in line 8-9 of claim 16 is not adequately described in the specification. It is unclear what the applicant means by “attendant processing.”

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-4, and 11-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Fitzpatrick et al. (USPN 5,420,936), hereafter Fitzpatrick.

9. Regarding claim 1, Fitzpatrick discloses an information processing apparatus comprising: fingerprint verification means for verifying a fingerprint read from a fingerprint reading surface against previously stored fingerprints of authorized users (column 3, line 52-65), the information processing apparatus further comprising: display means having a display surface with orthogonal coordinates set thereon (figure 3, element 50); coordinate designating means for designating coordinates related to fingerprint reading on the display surface (column 4, line 3-10); and control means (84) for controlling an operation based on designated coordinates (column 4, line 10-26).



10. Regarding claim 2, Fitzpatrick discloses that the display surface and the fingerprint reading surface are one and the same (column 3, line 52-57).
11. Regarding claim 3, Fitzpatrick discloses that the fingerprint reading surface is formed on the coordinate designating means (column 4, line 3-10).
12. Regarding claim 4, Fitzpatrick discloses that the control means activates the fingerprint verification means when specific coordinates are designated (column 4, line 16-26).
13. Regarding claim 11, Fitzpatrick discloses that the information processing apparatus further comprises: icon setting means for setting an icon associated with an application (column 4, line 10-14); and icon designation judging means for judging whether the set icon is designated or not, based on designated coordinates (column 4, line 3-10), wherein when the icon is designated and there is a match in fingerprint as a result of the fingerprint verification, the control means reads out only data of a user having the matching fingerprint in an application associated with the designated icon and causes the data to be displayed (column 4, line 14-26).
14. Regarding claim 12, Fitzpatrick discloses that when an icon is designated and there is a match in fingerprint as a result of the fingerprint verification, the control means initiates an application associated with a user having the matching fingerprint among applications previously set for the respective authorized users ("per-icon" access table 76, column 4, line 18-26).
15. Regarding claim 13, Fitzpatrick discloses that the respective icons are associated with files for the respective authorized users; and when an icon is designated and there is a match in fingerprint as a result of the fingerprint verification, the control means opens only a file (program/data) of a user having the matching fingerprint out of files associated with the designated icon (column 4, line 18-26).



***Claim Rejections - 35 USC § 103***

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 5, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fitzpatrick as applied to claim 1 above, and further in view of Mori et al. (USPN 5,040,142), hereafter Mori.

18. Regarding claim 5, Fitzpatrick does not disclose that the information processing apparatus further comprises a secret number acquiring means. Mori discloses an electronic document review method comprising secret number acquiring means (143) for acquiring a secret number (column 5, line 4-11); and secret number identifying means for verifying the acquired secret number against a previously stored secret number (column 8, line 64 to column 9, line 5), wherein the control means controls an operation based on a result of the secret number verification (column 9, line 5-13). It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize a secret number acquiring means as taught by Mori in order to further verify a user's identity and to look up any data for the user such as a seal or fingerprint image.

19. Regarding claim 15, Fitzpatrick does not disclose the processing of a document having a seal box. Mori discloses that a document having a seal box is displayed on the display means (column 5, line 1-19); and when detected coordinates are coordinates of the seal box (column 4, line 45-47), the control means affixes an approval seal in the seal box of the document, the



information processing apparatus further comprising: communication means for communicating an approval-seal affixed document (column 4, line 53-58). It would have been obvious to one of ordinary skill in the art at the time the invention was made to process a document having a seal box as taught by Mori in order to securely process shared documents and allow for approval/review of the documents (column 3, line 49-65).

20. Regarding claim 16, Fitzpatrick does not disclose the processing of a document having a seal box utilizing attendant processing. Mori discloses that a document having a seal box is displayed on the display means; and when detected coordinates are coordinates of the seal box, the control means affixes an approval seal in the seal box of the document (see discussion of claim 15 above), the information processing apparatus further comprising: attendant processing means (here attendant processing is interpreted as circulating a document between a plurality of users who must each submit their individual approval) for subjecting an approval-seal affixed document to an attendant processing (column 3, line 66 to column 4, line 25). It would have been obvious to one of ordinary skill in the art at the time the invention was made to process a document having a seal box using attendant processing as taught by Mori in order to securely process shared documents and allow for the documents to be reviewed/approved by a plurality of users.

21. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fitzpatrick in view of Mori as applied to claim 5 above, and further in view of Matsumura (USPN 5,493,621).

22. Mori does not disclose that the fingerprint verification means is activated when the secret numbers match each other. Matsumura discloses a fingerprint identification system and method wherein the control means activates the fingerprint verification means when the secret numbers



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match each other (column 11, line 44-54). It would have been obvious to one of ordinary skill in the art at the time the invention was made to activate the finger verification when the secret numbers match as taught by Matsumura in order to increase security and to reduce the time it takes to compare fingerprints since a user's fingerprint can be compared with a smaller subset of prints.

23. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fitzpatrick as applied to claim 1 above, and further in view of Angelo (USPN 5,887,131).

24. Fitzpatrick does not disclose operation of a power source when there is a fingerprint match. Angelo discloses an access control method for a computer system wherein a control means controls the operation of a power source of the information processing apparatus (column 8, line 7-34) when there is a match in fingerprint (column 7, line 26-33). It would have been obvious to one of ordinary skill in the art at the time the invention was made to operate a power source when there is a fingerprint/password match as taught by Angelo in order to prevent repeated attempts to gain unauthorized access to the system.

25. Claims 8-10 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fitzpatrick as applied to claim 1 above, and further in view of Shieh (USPN 5,874,948).

26. Regarding claim 8, Fitzpatrick does not disclose reading an operating condition associated with each user. Shieh discloses when there is a match as a result of the verification of the read fingerprint against the previously stored fingerprints, the control means reads out an operation condition associated with an authorized user having the matching fingerprint from among operation conditions previously set for the authorized users and sets the condition (column 4, line 28-42). It would have been obvious to one of ordinary skill in the art at the time



the invention was made to read an operating condition associated with each user as taught by Shieh in order to allow users to customize their working environment.

27. Regarding claim 9, Fitzpatrick does not expressly disclose that all fingers on both hands can be verified. Shieh discloses that the fingerprint verification means is capable of verifying fingerprints of all fingers of both hands (column 3, line 55-63). It would have been obvious to one of ordinary skill in the art at the time the invention was made to verify all fingers of both hands as taught by Shieh in order to associate commands with each identifying feature.

28. Regarding claim 10, Fitzpatrick does not disclose associating a command with each finger of the user. Shieh discloses that when the fingerprints of the respective fingers match the previously stored ones, the control means reads out a command associated with each finger of the user having the matching fingerprints, from among commands previously registered for the respective fingers of the authorized user and executes the commands (figure 2; column 5, line 1-18). It would have been obvious to one of ordinary skill in the art at the time the invention was made to associate commands with each finger as taught by Shieh in order to give the user shortcut functions at their fingertips, and to allow further customization.

29. Regarding claim 14, Fitzpatrick does not expressly disclose the use of menus. Shieh discloses that the information processing apparatus further comprises: menu execution level area setting means for setting an area associated with an execution level of a menu (column 5, line 18; column 6, line 7-12); and menu execution level area designation judging means for judging based on designated coordinates whether a set menu execution level area is designated or not (column 3, line 15-23), wherein when a menu execution level area is designated and there is a match in fingerprint, the control means executes a menu at an execution level associated with an



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authorized user having the matching fingerprint among execution levels previously set for the respective users (column 4, line 28-42), as well as an execution level of the designated menu execution level area (column 5, line 30-32). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the use of menus as taught by Shieh in order to allow the added functionality of a plurality of functions hidden in a drop down menu or the like.

### *Conclusion*

30. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- USPN 5,924,109 to Ackerman et al. discloses a document approval method using a communications network.
- USPN 6,144,756 to Takahashi et al. discloses a finger verification system using user specific information.
- USPN 5,748,184 to Shieh discloses a virtual pointing device for touch screens.
- USPN 5,745,686 to Saito et al. discloses an information tracing system and method.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan J Hesseltine whose telephone number is 703-306-4069.

The examiner can normally be reached on Monday - Friday, 8 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amelia Au can be reached on 703-308-6604. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

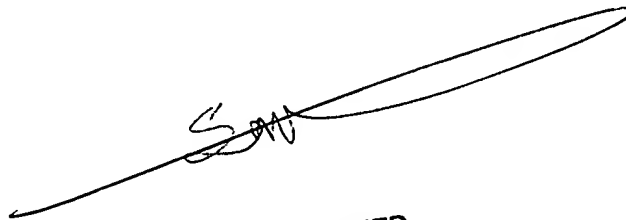


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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0377.

rjh  
December 6, 2002

A handwritten signature in black ink, appearing to read 'SAMIR AHMED', is written over a long, thin, slightly curved line that spans across the middle of the page.

**SAMIR AHMED  
PRIMARY EXAMINER**